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In re application of
WAKAYAMA et al.
Serial No.: 09/601,390
Filed: July 31, 2000
For: FILTER MEDIUM FOR AIR FILTER AND PROCESS
FOR PRODUCING THE SAME

:
: **DECISION ON**
: **PETITION**
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:

This is a decision on the petition under 37 CFR 1.144 filed April 18, 2002, in Paper No. 9, to review the restriction requirement as set forth in the action mailed on September 28, 2001, in Paper No. 5.

BACKGROUND

The present application was filed on the national stage under the provisions of 35 USC 371. In reviewing the propriety of a restriction requirement, i.e. the presence or absence of "Unity of Invention," in such an application it is understood that unity of invention is to be evaluated by the criteria described in PCT Rules 13.1-13.2 or 37 CFR 1.475. According to PCT Rule 13.2:

Where a group of inventions is claimed in an application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Furthermore, 37 CFR 1.475 (b) or Annex B to the "PCT Administrative Instructions" in Appendix AI of the *MPEP* describes different combinations of categories of inventions that may be held to have unity of invention due to their possession of such a technical relationship.

The examiner imposed a three way restriction under 35 USC 121, relying in part, on the argument that the three Groups of Invention, i.e., Group I, claims 1-8, and 17 directed to a filter medium and method for manufacturing a filter medium; Group II, claims 12-13 directed to a method for manufacturing semiconductors; and Group III, claims 9-11 and 14-16 directed to a clean room. The examiner further expands his explanation in that "Group I is directed to a filter medium having a special technical feature of a binder not shared by any of the remaining groups. Group II is directed to a method of manufacturing semiconductors having a special feature of a silicon wafer not shared by any of the remaining groups. Group III is directed to a clear room having the special feature of a clean bench, clean booth, wafer stocker, wafer transfer space, and semiconductor fabrication equipment not shared by any of the remaining groups".

Petitioner argues that the claims of Group III, namely, 9-11 and 14-16 are dependent claims, ultimately depending upon independent claim 1. Similarly, the claims of Group II, namely, 12-13 are also dependent

claims, ultimately depending upon independent claim 1. In addition, Petitioner contends that the special technical feature common to all of the claims is the air filter comprising a filter medium. The petitioner, then goes on to set forth example 13 found in Annex B to the "PCT Administrative Instructions" in Appendix AI of the *MPEP* as being analogous to claims 1-18.

DECISION

Upon review of the arguments above, the claims as filed, including the claims added in the preliminary amendment filed July 31, 2000, revealed that claims 9-11 are dependent upon claim 8 which in turn depends on claim 1. Claims 14, 15, and 16 were drafted to depend on claims 10, 12 and 13 respectively. Claims 12 and 13 also depending on claim 8.

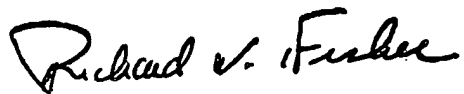
According to *MPEP* 1850 under the subtitle, "*Independent and Dependent Claims*" it is stated:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

In this case, the imposed restriction was considered in relation to the dependent claims 9-16 for Unity of invention. Due to their dependency, claims 9-16 contain all the features, the special technical feature, of claim 8 and consequently, of claim 1. Since the standard for restriction for application filed under 35 USC 371 has not been met, it is evident that the restriction is improper.

In view of the above discussion, the petition is **GRANTED**.

The application will be forwarded to the examiner for examination of all of the restricted claims present in the application, namely, Claims 9-16.



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